

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 14286US02

PATENT

In the Application of:)	
)	
Jeyhan Karaoguz, et al.)	<u>Electronically Filed On August 18, 2009</u>
)	
Serial No.: 10/667,833)	
)	
Filed: September 22, 2003)	
)	
For: MEDIA EXCHANGE NETWORK)	
SUPPORTING CONSUMPTION OF)	
BROADCAST AND USER)	
CAPTURED MEDIA)	
)	
Examiner: Cheema, Umar)	
)	
Group Art Unit: 2444)	
)	
Confirmation No.: 1002)	

SECOND PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal. No fee is believed due because the Applicants previously paid for the Notice of Appeal. See November 7, 2008 Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

Date: August 18, 2009

By: /Joseph M. Butscher/
Joseph M. Butscher
Reg. No. 48,326

REMARKS

The present application includes pending claims 1-48, all of which have been rejected. The Applicants respectfully submit that the Final Office Action fails to establish a *prima facie* case of unpatentability with respect to the pending claims for at least the following reasons.

Claim 1 recites, in part, “server software that **maintains a user defined association of the first and second network protocol addresses**, that receives a request that identifies one of the associated first and second network protocol addresses and responds by identifying the other of the associated first and second network protocol addresses **to support delivery via the communication network of the 3rd party media from the at least one server, and the first media from the first storage, to the second home, and the 3rd party media from the at least one server, to the first home, for concurrent consumption of the 3rd party media by the first television, and the 3rd party media and the first media by the second television.**”

The Final Office Action acknowledges that Lu “does not explicitly disclose wherein server software maintains a user defined association of the first and second network protocol addresses....” *See* July 7, 2009 Office Action at page 6. In an attempt to overcome this deficiency, the Office Action relies on Hoshen. *See id.*

The Applicants demonstrate, however, that Hoshen fails to overcome the deficiencies of Lu. *See* April 15, 2009 Amendment at pages 12-14.

Hoshen explicitly discloses that it is the cable management system, but not individual subscribers, that selects particular SSTBs for streaming media. *See id.* at pages 13-14. Again, however, there is nothing in Hoshen that describes, teaches or suggests user-defined association of network addresses with respect to other individual subscribers.

Hoshen does not describe, teach or suggest “server software that **maintains a user defined association of the first and second network protocol addresses.**” Further, the Office Action acknowledges that Lu does not describe, teach or suggest this limitation. *See* July 7, 2009 Office Action at page 6. Because neither Lu (as acknowledged by the Office Action) nor Hoshen describes, teaches or suggest this limitation, the combination of both, by definition, also cannot describe, teach or suggest it. Accordingly, the Office Action has not established a *prima facie* case of obviousness with respect to claims 1, 15, 35 and the claims that depend therefrom unpatentable.

Additionally, the Office Action cites Lu at **column 6, lines 21-28 and 39-61** as disclosing “support[ing] delivery via the communication network of the 3rd party media from the at least one server, and the first media from the first storage, to the second home, and the 3rd party media from the at least one server, to the first home.” *See* July 7, 2009 Office Action at pages 5-6. The Applicants demonstrate, however, that these cited portions of Lu simply do not describe, teach or suggest this limitation. *See* April 15, 2009 Amendment at pages 14-18.

The Office Action also acknowledges, however, that Lu “does not explicitly disclose ... wherein supporting delivery via the communication network of the 3rd party media from at least one server to first and second home.” *See* July 7, 2009 Office Action at page 6. As explained in the April 15, 2009 Amendment at pages 14-16, however, Lu does not describe, teach or suggest “support[ing] **delivery** via the communication network of the 3rd **party media from the at least one server, and the first media from the first storage, to the second home, and the 3rd party media from the at least one server, to the first home, for concurrent consumption** of the 3rd party media by the first television display, and the 3rd party media and the first media by the second television display,” as recited in claim 1. The Office Action cites Hoshen at Abstract,

[0003], [0078], [0085], [0055]-[0060] and Figures 1-3 as disclosing these limitations. *See* July 7, 2009 Office Action at page 6. However, a review of these cited portions of Hoshen demonstrates that they do not describe, teach or suggest “support[ing] **delivery** via the communication network of the 3rd party media from the at least one server, and the first media from the first storage, to the second home, and the 3rd party media from the at least one server, to the first home, for concurrent consumption of the 3rd party media by the first television display, and the 3rd party media and the first media by the second television display,” as recited in claim 1. As shown above, the claim is clear that 3rd party media from a server AND first media from a first storage are delivered to a second home, while 3rd party media is also sent to the first home, such that the third party media is concurrently displayed on the first and second television displays. The Office Action has not shown that any of the cited references describes, teaches or suggests these limitations.

The Applicants requested that the Final Office Action specifically and particularly quote portions of the cited references that tended to disclose these limitations, if the rejection was to be maintained. *See* April 15, 2009 Amendment at page 17. However, the Final Office Action simply reiterates the exact same rejection, with the same general, non-particular citations. *See* July 7, 2009 Office Action, particularly at pages 2-4. In other words, the Final Office Action was unable to specifically cite and particularly quote pinpoint examples of where the cited references disclosed the limitations noted above. Thus, for at least these additional reasons, the Office Action has not established a *prima facie* case of unpatentability with respect to the claims.

For at least the reasons discussed above, the Applicants respectfully request reconsideration of the claim rejections. The Applicants respectfully submit that the Office Action has not established a *prima facie* case of anticipation or obviousness with respect to any

of the pending claims for at least the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn.

Moreover, the present application has been pending since September 22, 2003, and has undergone extensive prosecution. For example, the Applicants filed a Second Notice of Appeal and an Appeal Brief on November 7, 2008. After reviewing the Appeal Brief, prosecution was reopened and a new rejection was entered. *See* February 6, 2009 Office Action.

The Examiner has had numerous opportunities to search for prior art and examine the pending claims. In doing so, the principles of compact prosecution have undoubtedly been violated. *See* MPEP § 2106(II). Accordingly, the Applicants respectfully request that the Panel allow the present application, as opposed to simply reopening prosecution for another round of prosecution. Not only will doing so be more in line with the principles of compact prosecution, it will also undoubtedly reduce the current backlog of pending applications (and/or backlog of appeals) that continues to bedevil the USPTO.

As noted above, no fee is believed due with respect to this Paper or the Notice of Appeal, as the fee for Notice of Appeal has already been paid. *See* November 7, 2008 Notice of Appeal. Nevertheless, the Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: August 18, 2009

MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100

/Joseph M. Butscher/
Joseph M. Butscher
Registration No. 48,326